



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,125	10/10/2003	Xiao Zhang	ROC920030245US1	2745
46797 7590 05/21/2008 IBM CORPORATION, INTELLECTUAL PROPERTY LAW DEPT 917, BLDG. 006-1 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829				
EXAMINER				
MYHRE, JAMES W				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
05/21/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/684,125

**Applicant(s)**

ZHANG, XIAO

**Examiner**

JAMES W. MYHRE

**Art Unit**

3688

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 33-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 33-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. This Office Action is in response to the Amendment filed on March 14, 2008. The Amendment cancelled Claims 16-32, added new Claims 33-43, and amended Claims 1-6, 9, and 10. Therefore, the currently pending claims considered below are Claims 1-15 and 33-43.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-15 and 33-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Henson (6,167,383).

Claims 1, 5, and 9: Henson discloses a method for cross-selling products based on a system configuration, comprising:

- a. receiving an order (product selection) from a user (Figures 3a-3c; column 4, lines 41-47; and column 6, lines 18-43);
- b. determining if there are one or more cross-sells based on the ordered products and the state (configuration) of the system (column 10, lines 30-48);

- c. presenting the discounted cross-sells to the user based on the state (configuration) of the system (column 6, lines 39-43; column 7, lines 22-41; and column 9, line 40 – column 10, line 18); and
- d. calculating the price of the newly configured system (Figures 3a-3c).

The Examiner notes that the Applicant has defined "cross-sells" to include "cross-sell products may be offered at a discounted price (or be entirely free), but only when purchased along with another specific product." (page 10, paragraph 0039). Henson explicitly discloses offering the user "McAfee VirusScan 3.1 at no additional charge" when the user has selected Microsoft Windows 95 or 98. (Figure 3a). Thus, Henson is offering a cross-sell "at a discount based on the state of the system", but only when it "is determined to be compatible with the state of the system", i.e. only when the user has selected Microsoft Windows 95 or 98.

Claim 2: Henson disclose a method as in Claim 1 above, and further discloses the order (products) has been processed to verify the validity (compatibility) of the system as it is received (column 10, lines 30-48).

Claims 3, 12, and 13: Henson discloses a method as in Claim 1 and 9 above, and further discloses that the individual products have been validated as they are received to ensure compatibility with the system so that the system can operate properly (Figures 3a-3c and column 7, line 57 – column 8, line 44).

Claims 4 and 11: Henson discloses a method as in Claims 1 and 9 above, and further discloses qualifying the order is based on predefined conditions (column 10, lines 30-48).

Claim 6: Henson discloses a method as in Claim 1 above, and further discloses receiving a selection of a cross-sell product from the user and adding that selected product to the system (Figures 3a-3c). The Examiner notes that the system has already determined that the cross-sell product is compatible with the system before offering the cross-sell to the customer (see Claim 1 above). Thus, it is inherent that the cross-sell product selected by the user is compatible. Nonetheless, Henson also discloses presenting a message to the user indicating when an incompatible product has been selected by the user (column 5, lines 1-2; column 6, lines 39-43; column 7, lines 22-38 and 57-61).

Claims 7 and 14: Henson discloses a method as in Claims 1 and 9 above, and further discloses presenting the cross-sell products via a graphical user interface (GUI) (column 6, lines 39-43; column 7, lines 22-41; and column 9, line 40 – column 10, line 18).

Claims 8, 10 and 15: Henson discloses a method as in Claims 7, 9, and 14 above, and further discloses a selectable graphical element that enables the user to add one or more of the cross-sell products to the system (Figures 3a-3c).

Claim 33: Henson discloses a method for cross-selling products based on a system configuration, comprising:

- a. receiving user selection of one or more components of a configured system (Figures 3a-3c; column 4, lines 41-47; and column 6, lines 18-43);
- b. determining, based on the selected components, one or more cross-sell products that may be added to (i.e. compatible with) the system (column 10, lines 30-48);
- c. determining a discounted value for each of the cross-sell products (inherent);
- d. providing to the user one or more indications (i.e. a list of the cross-sell product or products) along with the determined discount price (Figure 3a);
- e. receiving a user selection of a cross-sell product and adding it to the system (Figures 3a-3c); and
- f. presenting a message to the user indicating a valid or invalid selection (column 5, lines 1-2; column 6, lines 39-43; column 7, lines 22-38 and 57-61).

The Examiner notes that the claimed steps referencing “software wizards to assist the user in configuring the configured system” are the equivalent to the steps performed by Henson’s “configuration, pricing, validation, shipment delay indication, and merchandising modules” (column 6, lines 31-34), and are reiterations of the steps a-e above for each new component product selected by the user.

Art Unit: 3688

Claim 34: Henson discloses a method as in Claim 33 above, and further discloses applying matching logic to determine whether the component product satisfies predefined conditions. Henson explicitly discloses offering the user "McAfee VirusScan 3.1 at no additional charge" when the user has selected Microsoft Windows 95 or 98. (Figure 3a). Thus, Henson is offering a cross-sell "at a discount based on the state of the system", but only when it "is determined that the component satisfies predefined conditions", i.e. only when the user has selected Microsoft Windows 95 or 98.

Claims 35 and 36: Henson discloses a method as in Claim 33 above, and further discloses a limited quantity of the cross-sell product based on one or more component products selected by the user (column 8, lines 34-55). Henson gives an example of the system providing a warning message to the user when a motherboard will allow only three things to be added and the user attempts to select a fourth product.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (6,167,383).

Claim 37: Henson discloses a method for cross-selling products based on a system configuration, comprising:

- a. receiving user selection of one or more components of a configured system (Figures 3a-3c; column 4, lines 41-47; and column 6, lines 18-43);
- b. determining, based on the selected components, one or more cross-sell products that may be added to (i.e. compatible with) the system (column 10, lines 30-48);
- c. determining a discounted value for each of the cross-sell products (inherent);
- d. providing to the user one or more indications (i.e. a list of the cross-sell product or products) along with the determined discount price (Figure 3a);
- e. receiving a user selection of a cross-sell product and adding it to the system (Figures 3a-3c); and
- f. presenting a message to the user indicating a valid or invalid selection (column 5, lines 1-2; column 6, lines 39-43; column 7, lines 22-38 and 57-61).

While Henson does not explicitly disclose receiving a second configured system based on a previous order from the same user, it is disclosed that the user may be an individual, a business (small, medium, or large), or a government employee (Figure 8) and it is also disclosed the system asks if the user is a previous customer (Figure 7). The Examiner also notes that compatibility with legacy systems is always a main concern to businesses looking to upgrade or expand their existing systems. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Henson to check the compatibility of the component of the new system to



Art Unit: 3688

each other, but also the compatibility of the components (and the whole system) with one or more previously ordered systems. One would have been motivated to do such a compatibility check between the systems in order to allow businesses to integrate the new system with their legacy systems. Additionally, if it is determined that the two systems are not compatible (e.g. old Mac system vs new PC system), such a determination may provide the opportunity for the merchant to present an offer to the user for additional software or hardware, such as a MAC to PAC converter.

Claim 38: Henson discloses a method as in Claim 37 above, and further discloses the discount (free McAfee VirusScan software) is based on the first configured system (Figure 3a).

Claims 39 and 40: Henson discloses a method as in Claim 37 above, but does not explicitly disclose that the discount is based on the second or both of the systems. However, as discussed above, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Henson to select a cross-sell (discount) based not only on the currently selected system (first system), but also based in whole or in part on any previously ordered system (i.e. legacy system) of the user. One would have been motivated to select the cross-sell based at least in part on the user's legacy system in order to allow easier updates of the system, eliminate the need to maintain several similar programs (e.g. using both McAfee and Norton anti-virus software within the business' system), etc.

Claim 41: Henson discloses a method as in Claim 37 above, and further discloses the discount is the entire price of the product, i.e. a free product (Figure 3a).

Claims 42 and 43: Henson discloses a method as in Claim 37 above, and further discloses a limited quantity of the cross-sell product based on one or more component products selected by the user (column 8, lines 34-55). Henson gives an example of the system providing a warning message to the user when a motherboard will allow only three things to be added and the user attempts to select a fourth product.

### ***Response to Arguments***

6. Applicant's arguments filed March 14, 2008 have been fully considered but they are not persuasive.

The Applicant argues that Henson "does not disclose offering cross-sell products at any kind of discount, much less at a discount based on a state of a system." (page 12). However, the Examiner notes as discussed above that Henson explicitly discloses offering the user free McAfee VirusScan software (i.e. at a 100 percent discount) if the user has selected Microsoft Windows 95 or 98 as the operating system (i.e. the state of the system).

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES W. MYHRE whose telephone number is (571)272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JWM  
May 19, 2008

/James W Myhre/  
Primary Examiner, Art Unit 3688